

**REMARKS/ARGUMENTS**

The Applicant submits herewith an Application Data Sheet with updated information.

The Applicant calls attention to a commonly-owned patent application in the same field, namely, co-pending U.S. Patent Application Serial No. 10/399,560, filed April 18, 2003, a national phase entry of PCT/CA01/01473 filed October 18, 2001, and which claims the benefit of U.S. Provisional Application 60/292,648 filed May 21, 2001 and of Canadian Patent Application No. 2,323,856 filed October 18, 2000. To the extent the Examiner believes a double patenting issue may eventually be raised, the Applicant wishes to call attention to such application.

The Applicant summarize the status of the application as follows:

Claims 1-56, 70-81, 83-89, 91-141 are pending.

**Rejections under 35 U.S.C. §102(e)**

1. Claims 1, 3, 5, 9, 14-21, 24, 30-32, 38-39, 46-47, 49-53, 56, 84, 87-90 stand rejected under 35 U.S.C. §102(e) as being anticipated by Miller et al. in U.S. Patent No. 5,896,321 (Paragraph 2, Page 2).
2. Claims 57 and 64 under 35 U.S.C. §102(e) stand rejected as being anticipated by LaGrange et al. in U.S. Patent No. 5,914,708 - incorrectly cited by the Examiner as U.S. Patent No. 5,896,321 (Paragraph 3, Page 15).

**Rejections under 35 U.S.C. §103(a)**

1. Claims 2, 48, 81, 83, 85-86 under 35 U.S.C. §103(a) stand rejected as being unpatentable over Miller in view of Appelman et al. (Paragraph 5, Page 18);
2. Claim 4 under 35 U.S.C. §103(a) stand rejected as being unpatentable over Miller (Paragraph 6, Page 25);
3. Claims 6, 8, 10-11 and 13 under 35 U.S.C. §103(a) stand rejected as being unpatentable over Miller in view of Agulnick et al. (Paragraph 7, Page 26);
4. Claim 7 under 35 U.S.C. §103(a) stands rejected as being unpatentable over Miller in view of Forcier in U.S. Patent No. 5,220,649 (Paragraph 8, Page 29);
5. Claims 12, 26 and 92 under 35 U.S.C. §103(a) stand rejected as being unpatentable over Miller in view of Niemeier in U.S. Patent No. 5,574,482 (Paragraph 9, Page 30);

6. Claims 22-23, 25, 33, 54-55 and 91 under 35 U.S.C. §103(a) stand rejected as being unpatentable over Miller in view of Skinner et al. in U.S. Patent No. 6,661,920 (Paragraph 10, Page 32);
7. Claims 27-29, 34 under 35 U.S.C. §103(a) stand rejected as being unpatentable over Miller in view of Skinner and in further view of Lee in U.S. Patent No. 6,292,179 (Paragraph 11, Page 38);
8. Claim 35 under 35 U.S.C. §103(a) stand rejected as being unpatentable over Miller in view of Skinner and in further view of LaGrange et al. in U.S. Patent No. 5,914,708 (Paragraph 12, Page 40);
9. Claim 36 under 35 U.S.C. §103(a) stand rejected as being unpatentable over Miller in view of Skinner and in further view of Bi in U.S. Patent No. 6,262,719 (Paragraph 13, Page 42);
10. Claims 40-42 under 35 U.S.C. §103(a) stand rejected as being unpatentable over Miller in view of Bi (Paragraph 14, Page 43);
11. Claim 43 under 35 U.S.C. §103(a) stands rejected as being unpatentable over Miller in view of Bi and in further view of LaGrange (Paragraph 15, Page 44);
12. Claims 44-45 under 35 U.S.C. §103(a) stand rejected as being unpatentable over Miller in view of Bi and in further view of Skinner (Paragraph 16, Page 46);
13. Claims 58-60 and 65-67 under 35 U.S.C. §103(a) stand rejected as being unpatentable over LaGrange in view of Skinner and in further view of Miller (Paragraph 17, Page 46);
14. Claims 61 and 68 under 35 U.S.C. §103(a) stand rejected as being unpatentable over LaGrange in view of Skinner (Paragraph 18, Page 54);
15. Claims 62 and 69 under 35 U.S.C. §103(a) stand rejected as being unpatentable over LaGrange in view of Niemeier (Paragraph 19, Page 55);
16. Claim 63 under 35 U.S.C. §103(a) stands rejected as being unpatentable over LaGrange in view of Miller (Paragraph 20, Page 57);
17. Claims 70-71, 73-79, and 80 under 35 U.S.C. §103(a) stand rejected as being unpatentable over Skinner in view of Miller (Paragraph 21, Page 58); and
18. Claim 72 under 35 U.S.C. §103(a) stands rejected as being unpatentable over Skinner in view of Miller and in further view of LaGrange (Paragraph 22, Page 66).
1. **Rejection of Independent Claim 1 and Dependent Claims Thereof**

In Paragraph 2 of the Office Action, the Examiner has rejected Claims 1, 3, 5, 9, 14-21, 24, 30-32, 38-39 and 46 under 35 U.S.C. §102(e) as being anticipated by Miller (U.S. Patent No. 5,896,321). In Paragraphs 5-16 of the Office Action, the Examiner has further rejected certain claims dependent upon Claim 1, specifically Claims 2, 4, 6-8, 10-13, 22-23, 25-29, 33-36, and 40-45 under 35 U.S.C. 103(a), relying on Miller as one of the references.

(a) Claim 1

Applicant's Claim 1 as amended recites:

"A method of processing text entered into a personal computing device with a pointing device, the method comprising:

- (a) receiving a partial text entry comprising at least a first character;
- (b) in response to receipt of the first character of the partial text entry, obtaining a dynamically generated list of completion candidates based on the partial text entry;
- (c) displaying the list of completion candidates in a search list within a graphical user interface;
- (d) receiving a user input signal associated with the pointing device;
- (e) if the user input signal corresponds to a first type of user selection with the pointing device, deactivating the search list; and
- (f) if the user input signal corresponds to a second type of user selection with the pointing device, replacing the partial text entry with a completion candidate from the search list."

Miller discloses a text completion system (200) in which at least two antecedent requirements must be met before word completion suggestions will be obtained. Firstly, Miller determines whether a pause of predetermined duration in the entry of a stream of characters has occurred (block 408 in Fig. 4; col. 17, line 66 ff.). In this regard, Miller uses a pause threshold of 0.5 seconds as a trigger (col. 18, line 4). If there is no pause of predetermined duration in the entry of characters, Miller's system will not obtain word completion suggestions (block 408 in Fig. 4). Secondly, Miller requires that the partial data entry contains a minimum number of characters, which Miller tests for using a "search criteria" (block 410 in Fig. 4; col. 12, lines 24-28). Miller's system will not obtain word completion suggestions unless, in addition to detecting a pause by the user of predetermined duration, at least a minimum number of characters have been entered, which Miller sets at three characters (col. 12, lines 24-28). Miller's requirements of both a pause of predetermined duration in the entry of the partial data entry and of a partial data

entry containing a minimum number of characters are antecedent requirements to invoking Miller's word prediction system (block 412 in Fig. 4).

Claim 1 has been amended to more clearly and distinctly point out that a dynamically generated list of completion candidates based on the partial text entry may be obtained in response to receipt of the first character in the partial text entry. The ability to obtain completion candidates as the first character in the partial text entry is received may be particularly useful as it produces earlier completion candidates for possible use. Nowhere does Miller disclose or suggest obtaining a dynamically generated list of completion candidates based on the partial text entry as the first character in the partial text entry is received. Furthermore, Miller does not disclose the combination of the elements set forth in the method recited in Claim 1. As indicated above, in order for Miller to obtain completion suggestions, Miller first requires both a pause of predetermined duration in the entry of a stream of characters by the user and that the partial data entry contain a minimum number of characters, which he sets at three. In view of these distinctions alone, it is respectfully submitted that Claim 1 as amended is allowable over Miller.

(b) Elements (e) and (f) of Claim 1

It will be noted that applicant's Claim 1 includes, in element (e), a first type of user selection to deactivate the search list and, in element (f), a second type of user selection to replace a partial text entry with a completion candidate from the search list.

With respect to element (e) of Claim 1, the Examiner has cited block 428 of Figure 4 in Miller wherein Miller illustrates discontinuing the display of a list of completion suggestions in response to receiving an acceptance command (block 424) after the partial data entry has been completed with additional characters of the selected (i.e., accepted) completion suggestion (block 426). With respect to element (f) of Claim 1, the Examiner has cited col. 5, lines 28-35 of Miller, wherein Miller describes that, "in response to the acceptance command, the text completion system completes the partial data entry with the additional characters of the particular completion suggestion and discontinues the display of the prioritized list of completion suggestions".

The Examiner's reference to block 428 of Figure 4 and to column 5, lines 28-35 of Miller, in connection with elements (e) and (f) of the present Claim 1, appears to be based on a misunderstanding of the two portions of Miller referred to by the Examiner in that Column 5, lines 28-35 in Miller is merely a summary of the subject matter described by block 428 in Figure 4. In other words, both citations refer to the same thing: both citations describe the response (discontinuing the display) to just one type of user selection (an acceptance command). However, in applicant's Claim 1, elements (e) and (f) are clearly distinct, and correspond to two different types of user selections ("first type of user selection... deactivating the search list" and "second type of user selection... replacing the partial text entry with a completion candidate from the search list"). Therefore, the objection would appear to be improper and should be withdrawn. If the Examiner disagrees, the applicant respectfully requests that the Examiner

clarify precisely how the subject matter in block 428 of Figure 4 amounts to a "first type of user selection" whereas the subject matter in column 5, lines 28-35 amounts to a "second type of user selection", as claimed.

(c) Miller Expressly Teaches Away

In addition, it will be noted that Miller expressly teaches one skilled in the art to avoid using short partial data entries to obtain word completion suggestions (col. 12, lines 19-28). As indicated in column 12, lines 19-24, Miller teaches that short partial data entries are "too short to serve as a reasonable indication of the complete data entry that the user is in the process of entering" and that obtaining and displaying completion suggestions based on such short partial data entries is therefore to be avoided. In fact, Miller teaches using a search criteria to "avoid annoying the user by displaying an excessive number of wrong completion suggestions". Thus, Miller expressly teaches away from the method recited in applicant's amended Claim 1.

(d) Miller and Rejection of Claims 3, 5, 9, 14-21, 24, 30-32, 38-39, 46 under 35 U.S.C. §102(e)

In Paragraph 2, the Examiner has rejected Claims 3, 5, 9, 14-21, 24, 30-32, 38-39, and 46 under 35 U.S.C. §102(e) as being anticipated by Miller. Claims 3, 5, 9, 14-21, 24, 30-32, 38-39, 46 are dependent upon independent Claim 1, which, as shown above, is not anticipated by Miller. Accordingly, it is respectfully submitted that these claims are allowable due to their dependencies, as well as due to the additional subject matter each of these claims recites.

(e) Miller and Rejections to Claims 2, 4, 6-8, 10-13, 22-23, 25-29, 33-36, and 40-45 under 35 U.S.C. §103(a)

In Paragraphs 5-16 of the Office Action, the Examiner has rejected certain claims dependent upon Claim 1, specifically Claims 2, 4, 6-8, 10-13, 22-23, 25-29, 33-36, and 40-45, under 35 U.S.C. §103(a) in which the Examiner relies on Miller as one of the references. In view of the comments made above with respect to Claim 1 and Miller, it is respectfully submitted that Claims 2, 4, 6-8, 10-13, 22-23, 25-27, 29, 33-36, and 40-45 are allowable due to their dependencies, as well as due to the additional subject matter each of these claims recites. Furthermore, Miller expressly teaches away from the invention claimed in amended Claim 1, and therefore Miller should not be used in combination with any other reference to form the basis of a rejection under 35 U.S.C. §103(a) for claims dependent upon Claim 1.

(f) Objection to Claim 37

In Paragraph 24, the Examiner has objected to Claim 37 as being dependent upon a rejected base claim, but indicated that this claim would be allowable if rewritten in independent form including all of the limitations of the base claim and intervening claims. In view of the

comments above with respect to Claim 1, applicant respectfully submits that Claim 37 is allowable in its current form and does not need to be rewritten.

## **2. Rejection of Independent Claim 47 and Dependent Claims Thereof**

In Paragraph 2 of the Office Action, the Examiner has rejected Claims 47, 49-53, and 56 under 35 U.S.C. §102(e) as being anticipated by Miller (U.S. Patent No. 5,896,321). In Paragraphs 5 and 10 of the Office Action, the Examiner has rejected certain claims dependent upon Claim 47, specifically Claims 48, 54 and 55, under 35 U.S.C. §103(a) in which the Examiner relies on Miller as one of the references.

### **(a) Miller and Claim 47**

Claim 47 element (b) has been amended to read "means for obtaining a dynamically generated list of completion candidates based on the partial text entry, "in response to receipt of the first character in the partial text entry"". As indicated earlier with reference to Claim 1, Miller fails to disclose any such approach and instead requires a pause of predetermined duration in the stream of characters entered by the user, and further requires that the partial data entry not be too short. On this basis alone, Claim 47 as amended is allowable over Miller.

Furthermore, Claim 47 is a system claim which includes in element (e) means for deactivating the search list and awaiting further user-initiated modification of the partial text entry if the user input signal corresponds to a first type of user selection with the pointing device, and in element (f) means for replacing the partial text entry with a completion candidate from the search list if the user input signal corresponds to a second type of user selection with the pointing device. The Examiner relies on block 428 of Figure 4 and to column 5, lines 28-35 of Miller, in connection with elements (e) and (f) of the present Claim 47. As explained earlier, column 5, lines 28-35 in Miller is a summary of the subject matter described by block 428 in Figure 4. In other words, both citations refer to the same thing: both citations describe the response (discontinuing the display) to just one type of user selection (an acceptance command). In applicant's Claim 47, elements (e) and (f) are clearly distinct, and correspond to two different types of user selections. Therefore, the objection should be withdrawn. If the Examiner disagrees, the applicant respectfully requests that the Examiner clarify precisely how the subject matter in block 428 of Figure 4 amounts to a "first type of user selection" whereas the subject matter in column 5, lines 28-35 amounts to a "second type of user selection", as claimed.

### **(b) Miller and Rejection of Claims 49-53, 56 under 35 U.S.C. §102(e)**

In Paragraph 2, the Examiner has rejected Claims 49-53 and 56 under 35 U.S.C. §102(e) as being anticipated by Miller. Claims 49-53 and 56 are dependent upon independent Claim 47, which, as shown above, is not anticipated by Miller. Accordingly, it is respectfully submitted that these claims are allowable due to their dependencies, as well as due to the additional subject matter each of these claims recites.

(c) Miller and Rejections to Claims 48, 54 and 55 under 35 U.S.C. §103(a)

In Paragraphs 5 and 10 of the Office Action, the Examiner has rejected Claims 48, 54 and 55 on the basis of an obviousness argument under 35 U.S.C. §103(a) in which the Examiner relies on Miller as one of the references. In view of the comments made above with respect to Claim 47 and Miller, it is respectfully submitted that Claims 48, 54 and 55 are allowable due to their dependencies, as well as due to the additional subject matter each of these claims recites. Furthermore, Miller expressly teaches away from using short partial data entries to obtain completion suggestions, and therefore it should not be used in combination with any other reference to form the basis of a rejection under 35 U.S.C. §103(a) of claims dependent upon Claim 47.

**3. Rejection of Independent Claims 57 and 64 and Dependent Claims Thereof**

In Paragraph 3 of the Office Action, the Examiner has rejected independent Claims 57 and 64 under 35 U.S.C. §102(e) as being anticipated by LaGrange et al. in U.S. Patent No. 5,914,708 (incorrectly cited by the Examiner as U.S. Patent No. 5,896,321). The Examiner has also rejected the claims dependent on Claims 57 and 64, specifically Claims 58-63 and Claims 65-69, respectively. While the applicant respectfully disagrees with the Examiner's rejections, by the present amendments, Claims 57-69 are canceled without prejudice to the applicant's right to pursue these claims at a later date.

**4. Rejection of Independent Claims 70 and 80 and Dependent Claims Thereof**

In Paragraphs 21 and 22 of the Office Action, the Examiner has rejected claims 70-80 on the basis of 35 U.S.C. §103(a) in which the Examiner relies on Miller as one of the references. With respect to Claims 70 and 80, the Examiner rejects these claims under 35 U.S.C. §103(a) as being unpatentable over Skinner (U.S. Patent No. 6,661,920) in view of Miller.

Minor editorial amendments have been made to Claim 70 to address certain antecedent issues and more distinctly clarify the meaning of the Claim.

The Examiner has suggested that Miller discloses element (c) of Claim 70, which recites, in part, "if the user input signal corresponds to activating an automated search to obtain the search list of completion candidates... replacing the digital keyboard with the search list". In this regard, the Examiner has cited column 5, lines 4-14 of Miller, wherein Miller teaches that, in response to a pause, the text completion system determines whether the partial data entry satisfies a search criteria. As noted earlier, Miller uses the search criteria to determine whether the partial data entry includes at least a predetermined number of characters, so as to avoid short partial data entries (see col. 12, lines 19-28). If this search criteria is met and if Miller detects a

pause of at least 0.5 seconds, the text completion system obtains a prioritized list of word predictions for the partial data entry from a word prediction system.

However, Miller and Skinner fail to disclose or suggest, either alone or in combination, "replacing the digital keyboard with the search list" as recited in applicant's Claim 70. Instead, Miller discloses displaying word suggestions in a pop-up box, which is located on the screen "in a non-intrusive manner, such as immediately under and to the right of the partial data entry" (col. 8, line 14), which, Miller states, "avoids obscuring text" (col. 12, line 60). Clearly, such a method of displaying completion suggestions does not involve any "replacing the digital keyboard with the search list" as recited in Claim 70. In addition, Skinner also fails to disclose "replacing" a virtual keyboard with a search list. Skinner merely discloses a method of simultaneously accepting characters from an on-screen virtual keyboard and a handwriting recognition mechanism, but this method does not involve "replacing the digital keyboard with the search list" as recited in Claim 70. Accordingly, neither Miller nor Skinner disclose or suggest, in combination or alone, the limitation of "replacing the digital keyboard with the search list" as recited in Claim 70. Applicant respectfully submits that Claim 70 is allowable over Miller and Skinner for this reason alone.

Similarly, Miller and Skinner fail to disclose or suggest, either alone or in combination, "replacing the search list with the digital keyboard" as recited in Claim 70. Miller teaches merely discontinuing a display of word suggestions but in no way teaches "replacing the search list with the digital keyboard" as recited in Claim 70. Moreover, Skinner fails to disclose or suggest even the use of a search list in the manner recited in Claim 70, much less replacing it with a digital keyboard. Accordingly, neither Miller nor Skinner disclose or suggest, alone or in combination, the limitation of "replacing the search list with the digital keyboard" as recited in Claim 70. Applicant therefore respectfully submits that Claim 70 is allowable over the combination of Miller and Skinner on this basis as well.

It will be noted that the combination of elements of the method recited in the Applicant's Claim 70 as amended comprises:

- "(a) displaying the digital keyboard in the user interface when a user is entering text a keystroke at a time;
- (b) monitoring for a user input signal;
- (c) if the user input signal corresponds to activating an automated search to obtain a list of completion candidates based on a partial text entry received by the personal computing device, replacing the digital keyboard with the search list containing the list of completion candidates and waiting for further user input; and
- (d) if the user input signal corresponds to terminating the automated search, replacing the search list with the digital keyboard and waiting for further user input."



In view of the arguments above with respect to Claim 70, not only do Miller and Skinner fail to teach "replacing the digital keyboard with the search list" or "replacing the search list with the digital keyboard", as further recited in Claim 70, they fail to disclose or suggest all of the elements of Claim 70 in the combination claimed.

In addition, Miller fails to disclose or suggest using a user input signal for activating an automated search as recited in element (c) of Claim 70. Rather, Miller teaches displaying a list of completion suggestions in response to a pause of predetermined duration in the receipt of data from the user. By detecting a pause, Miller effectively uses not a signal, but an absence of a signal, from the user in order to trigger displaying a list of completion suggestions. Since detecting a pause lies at the heart of Miller's system, the system described by Miller would have to be substantially redesigned to work in the way claimed in applicant's Claim 70. For this reason, it is respectfully submitted that Miller is not suitable as a reference for combination with other references. Skinner also fails to teach using a user input signal for activating an automated search. Applicant therefore respectfully submits that Claim 70 is allowable over the combination of Miller and Skinner for yet this additional reason.

Claim 80 is a means language claim generally following the language of Claim 70. Accordingly, the above arguments in respect of Claim 70 further apply to Claim 80. Therefore, it is respectfully submitted that Claim 80 is also allowable over the combination of Miller and Skinner.

In view of the comments made above with respect to Skinner and Miller in the context of Claim 70, Claims 71-79 should be allowable due to their dependencies, as well as due to the additional subject matter each of these claims recites.

## **5. Rejection of Independent Claim 81**

In Paragraph 5 of the Office Action, the Examiner has rejected Claim 81 under 35 U.S.C. §103(a) as being unpatentable over Miller in view of Appelman et al. in U.S. Patent No. 6,539,421 ("Appelman").

Appelman teaches a messaging application user interface (10) for instant messaging, on-line chat rooms and the like, and is concerned with the problem of how a user that is carrying on an exchange of messages with a plurality of other users can address, through a single messaging application user interface, one or more of the plurality of messaging recipients that the user is communicating with (col 2., lines 44-52). As part of the messaging application user interface, Appelman teaches a process (400) for automatically completing a partial user address that is entered in an input element (14 in Fig. 6) of the messaging application user interface (10) using a subset of potential messaging recipients (col 6, lines 8-11). This subset may be based on those persons in an address list who are currently online (col. 6, line 4).

In contrast, it will be noted that Claim 81 recites:

"A method of supporting text entry on a personal computing device by allowing a user to automatically search for and select completion candidates displayed in a search list based on a partial text entry, the method comprising:

- (a) receiving a user input signal;
- (b) if the user input signal corresponds to declining all completion candidates displayed in the search list, terminating automated searching with the search list with no consequence to the text being entered into the personal computing device;
- (c) if the user input signal corresponds to accepting a completion candidate from the search list to replace the partial text entry and to terminate automated searching, terminating the automated searching with the search list and modifying the partial text entry to become the accepted completion candidate; and
- (d) if the user input signal corresponds to selecting a completion candidate from the search list to initiate further searching, obtaining a new list of completion candidates based on the selected completion candidate and displaying the new list of completion candidates in the search list for further selection."

Applicant draws the Examiner's attention to element (b) of claim 81 which recites, in part: "if the user input signal corresponds to declining all completion candidates displayed... terminating automated searching". The Examiner has suggested (at p. 20) that Miller teaches an analogous function to that described by element (b) – namely, that Miller teaches in step (414) that an answer of "NO" discontinues previous display of word completion suggestions (if any) (step 416).

Applicant respectfully disagrees. Step 414 in Miller does not describe making a decision based on a user input signal. Rather, as described by Miller (col. 18, lines 18-31), step 414 involves determining whether any of the word predictions *received from the word prediction system 300* satisfy certain display criteria. The display criteria may include a requirement that a word completion include at least a predefined number of additional characters more than the partial data entry to qualify as a word completion suggestion. For example, a word prediction may be required to add at least three additional characters to the partial data entry to meet the display criteria. If there are no word predictions that satisfy the display criteria, the "NO" branch is followed from step 414 to step 416, in which Miller's text completion system 200 discontinues the previous display of completion suggestions, if any (col. 18, lines 27-30). Significantly, the decision in step 414 to follow the "NO" branch is based not on a user input signal, but on a preprogrammed display criterion. Accordingly, it is submitted that Miller fails to disclose element (b) of Claim 81. Appelman also fails to disclose or suggest element (b) of Claim 81.

Applicant respectfully submits that Claim 81 is therefore allowable over the combination of Miller and Appelmann for this reason alone.

In respect of element (d) of Claim 81, the Examiner has cited col. 3, lines 33-39 of Appelmann as teaching the use of user-selectable signals for modifying auto-completion behavior, and a predetermined criterion for selecting a subset of the plurality of potential message recipients. However, element (d) of Claim 81 recites, in part, "selecting a completion candidate from the search list to initiate further searching". Thus, applicant's search list has completion candidates that may be selected. Furthermore, the search list is in Claim 81 is "based on a partial text entry". Appelmann fails to disclose any "search list" which is "based on a partial text entry". Appelmann discloses receiving a partial address at step 404 in Fig. 10, as described at col. 6, lines 8-18 ff. In response to receiving the partial address, Appelmann teaches searching the partial address for a "signal", which may be one or more characters. For example, if the partial address begins with a dot character (i.e., ".") followed by a space, this may indicate that the auto-complete feature should use the "last address". However, Appelmann does not describe a search list based on the partial text entry. Appelmann describes an address list 200 in Fig. 9 and at column 5, lines 46-65, which may be based on the user's "buddy list" and/or the set of persons with whom the user has communicated in the current communication session (col. 5, lines 57-65). Yet Appelmann does not describe the address list 200 as being based on a partial text entry, thus the address list 200 is not equivalent to a "search list" in applicant's Claim 81.

Likewise, the subset 510 of the address list 200, used in the system described by Appelmann to attempt to auto-complete a partially entered address, is also not based on a partial text entry. Nor does Appelmann disclose any other element akin to applicant's search list. Since Appelmann fails to disclose a search list, it follows that Appelmann also fails to disclose "selecting a completion candidate *from* the search list *to* initiate further searching" as recited in Claim 81. Applicant concurs with the Examiner's statement (at p. 20 of the Office Action) that Miller also fails to teach this limitation. Applicant therefore respectfully submits that Claim 81 is allowable over the combination of Miller and Appelmann for this additional reason.

#### **6. Objection to Independent Claim 82**

In Paragraph 23, the Examiner has objected to Claim 82 as being identical to Claim 81. By the present amendment, Claim 82 is canceled, thereby overcoming the Examiner's objection.

#### **7. Rejection of Independent Claim 83**

In Paragraph 5, the Examiner has rejected Claim 83 under 35 U.S.C. §103(a) as being unpatentable over Miller in view of Appelmann.

In applying Miller to Claim 83, the Examiner has pointed to step (428) in Fig. 4 as disclosing the subject matter of element (e) of Claim 83. The Examiner has further cited column 5, lines 28-35 as disclosing the subject matter of element (f) of Claim 83. However, it appears

that the Examiner may have misinterpreted these two portions of Miller as disclosing distinctive subject matter, whereas, in fact, column 5, lines 28-35 in Miller are merely a summary of the subject matter described by block 428 in Figure 4. In other words, both citations refer to the same thing. Both citations describe the response (discontinuing the display) to just one type of user selection (an acceptance command). However, in Claim 83, elements (e) and (f) recite two different types of user selections. Therefore, the objection would appear to be improper and should be withdrawn. If the Examiner disagrees, the applicant respectfully requests that the Examiner clarify precisely how the subject matter in block 428 of Figure 4 amounts to a "first type of user selection" whereas the subject matter in column 5, lines 28-35 amounts to a "second type of user selection" as claimed by applicant.

The Examiner also appears to assert by analogy that element (g) of Claim 83 is somehow comparable to element (d) in Claim 81, although the Examiner has not made clear how this is the case. As explained above in relation to Claim 81, Appelman fails to disclose a "search list" having completion candidates and being based on a partial text entry. Moreover, Claim 83 recites, in part: "(g)... dynamically obtaining a refined list of completion candidates based on one of the completion candidates from the search list"; and "displaying the refined list of completion candidates in the search list for further user selection..." These aspects of element (g) also are not disclosed or suggested by Appelman inasmuch as they depend on having a "search list" as claimed. Thus, Appelman does not disclose element (g) of Claim 83. Applicant concurs with the Examiner's statement (at p. 22 of the Office Action) that Miller also fails to teach element (g) of Claim 83.

Accordingly, Miller and Appelman fail to disclose or suggest, either alone or in combination, all of the elements of Claim 83 in combination. Therefore, it is respectfully submitted that the rejection of Claim 83 is improper and should be withdrawn.

#### **8. Rejection of Claim 84 and 85**

In Paragraph 2 of the Office Action, the Examiner has rejected Claim 84 under 35 U.S.C. §102(e) as being unpatentable over Miller.

Claim 84 is a system claim comprising computer-readable instructions for, in element (c)(v), deactivating the search list if the user input signal corresponds to a first type of user selection, and computer-readable instructions for, in element (c)(vi), replacing the partial text entry with a completion candidate from the search list if the user input signal corresponds to a second type of user selection. The Examiner refers to block 428 of Figure 4 and to column 5, lines 28-35 of Miller, as disclosing elements (c)(v) and (c)(vi) in Claim 84. As indicated earlier, column 5, lines 28-35 in Miller is a summary of the subject matter illustrated by block 428 in Figure 4. In other words, both citations refer to the same thing: both citations describe the response (discontinuing the display) to just one type of user selection (an acceptance command). In applicant's Claim 84, elements (c)(v) and (c)(vi) are clearly distinct, and correspond to two different types of user selections. Therefore, the objection should be withdrawn. If the

Examiner disagrees, the applicant respectfully requests that the Examiner clarify precisely how the subject matter in block 428 of Figure 4 amounts to a "first type of user selection" whereas the subject matter in column 5, lines 28-35 amounts to a "second type of user selection", as claimed.

In view of the above comments regarding Claim 84, Claim 85 should be allowable due to its dependency on Claim 84, as well as due to the additional subject matter it recites.

## **9. Rejection of Independent Claim 86**

In Paragraph 5, the Examiner has rejected Claim 86 under 35 U.S.C. §103(a) as being unpatentable over Miller in view of Appelman et al.

At p. 24 of the Office Action, the Examiner has compared "accept[ing] a completion suggestion from the list by touching a stylus to the display screen over the position of the desired completion suggestion" described by Miller (col. 8, lines 17-19), to element (c) of Claim 86 which recites, in part, "selecting by gesture". The Examiner has also compared col 3, lines 33-39 of Appelman to element (d) of Claim 86. It will be noted that "selecting by gesture" is also recited in element (d) of Claim 86. In this regard, applicant has indicated the following at p. 23, lines 16-23 of the specification as filed:

For the purposes of this specification the term "gesture" refers to a motion with the pointing device when the pointing device is in an active state. In general, motions making up gestures may be linear or in another computer-recognizable pattern. For the first embodiment shown in FIG. 1 to 5 and for variations thereof, a gesture is a motion with the pointing device in a particular direction for at least a minimum distance when the pointing device is in an active state.

Miller does not disclose "selecting by gesture" within the meaning of the applicant's disclosure and as recited in element (c) of Claim 86. Nor does Appelman disclose "selecting by gesture" as recited in element (d) of Claim 86. Accordingly, Claim 86 is allowable over the proposed combination of Miller and Appelman on the basis of this distinction alone.

The Examiner also appears to assert by analogy that element (d) of Claim 86 is somehow comparable to element (d) in Claim 81, although the Examiner has not made clear how this is the case. As explained above in relation to Claim 81, Appelman fails to disclose a "search list". Similarly, Appelman fails to disclose an "interactive search list" as recited in Claim 86. As well, it is unclear to the applicant how Appelman could disclose "selecting... *from* the interactive search list" or "display[ing] *in* the interactive search list" inasmuch as these limitations depend on having an "interactive search list". If the Examiner believes element (d) of Claim 86 is disclosed by Appelman, the Examiner is respectfully requested to point out and distinctly identify the subject matter in Appelman which corresponds to an "interactive search list" analogous to the one claimed by applicant. Applicant concurs with the Examiner's statement (at

p. 25 of the Office Action) that Miller also fails to teach the limitations in element (d) of Claim 86.

Accordingly, Miller and Appelmann fail to disclose or suggest all of the elements of Claim 86 and applicant submits that the rejection to Claim 86 is overcome.

#### **10. Rejection of Independent Claim 87 and Dependent Claims Thereof**

In Paragraph 2 of the Office Action, the Examiner has rejected Claim 87-90 under 35 U.S.C. §102(e) as being unpatentable over Miller. In Paragraph 9, the Examiner has rejected Claim 92 under 35 U.S.C. §103(a) as being unpatentable over Miller in view of Niemeier (U.S. Patent No. 5,574,482). In Paragraph 10, the Examiner has rejected Claim 91 under 35 U.S.C. §103(a) as being unpatentable over Miller in view of Skinner et al. (U.S. Patent No. 6,661,920).

Claim 90 has been canceled. Claim 87 recites a method including the ability to act "in response to a prior located possible completion candidate or a character selectable by a user". In order to clarify that the recited method includes the ability to act in response to either "a prior located possible completion candidate" or "a character selectable by a user", applicant has made a clarifying amendment to Claim 87 to add the word "either". Applicant submits that Miller fails to disclose the ability to act "in response to either a prior located possible completion candidate or a character selectable by a user". Put another way,

- (a) Miller fails to disclose or suggest "locat[ing] a plurality of possible completion candidates... in response to... a prior located possible completion candidate";
- (b) Miller fails to disclose or suggest "locat[ing] a plurality of possible completion candidates... in response to... a character selectable by a user"; and
- (c) Miller fails to disclose the ability to do "either" (a) or (b) above.

Regarding points (a) and (b) above, Miller discloses obtaining a list of completion suggestions in response to a pause of predetermined duration in the entry of a stream of characters (col. 12, lines 10-16). Compare Claim 1 of Miller which recites, in part, "detecting a pause of a predetermined duration in the entry of the stream of characters; and in response to the pause, determining whether the partial data entry satisfies search criteria and, if the partial data entry satisfies the search criteria, obtaining a prioritized list of word predictions..." Thus, Miller teaches acting in response to a pause, not in response to a "prior located possible completion candidate", nor even in response to "a character selectable by a user". Accordingly, and additionally, it follows that Miller also fails to disclose the subject matter of Claim 87 as described in point (c) above.

In relation to Miller, the Examiner has referred at p. 14 of the Office Action to particular steps illustrated in Figure 4, including steps 414, 418, 420, 422 and 424, and to alternate ways of

selecting a completion suggestion, such as by using a physical keyboard or a stylus 42 in conjunction with the LCD display screen 47, for example. However, none of the subject matter in Miller referred to by the Examiner is equivalent to that recited in Claim 87. For example, even if it could be assumed that a "completion suggestion" in Miller is similar to a "completion candidate" in applicant's claim, the system described by Miller does not involve "locat[ing] a plurality of possible [completion suggestions]... in response to... a prior located possible [completion suggestion]". Even upon receiving an acceptance command in step 424, no additional locat[ing] of further completion suggestions occurs in Miller until step 412, and this occurs only upon fulfillment of numerous antecedent conditions, including detecting a pause in the receipt of data of at least a predetermined duration since the last character was received (in step 408). Accordingly, applicant submits that Miller fails to disclose or suggest the method recited in Claim 87.

Applicant respectfully submits that Claim 87 is allowable over Miller for at least the foregoing reasons.

In view of the comments made above with respect to Claim 87, it is submitted that Claims 88-89, 91-92 are allowable due to their dependencies, as well due to as the additional subject matter each of these claims recites.

Applicant has added new claims 93-141 reflecting subject matter which the Applicant believes it is further entitled to claim in view of the cited art.

#### CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



Kenneth R. Allen  
Reg. No. 27,301

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: (650) 326-2400  
Fax: (650) 326-2422  
KRA:deh

60253550 v1